

Application No.: 10/790,670
Filing Date: March 1, 2004

REMARKS

In response to the final Office Action mailed October 11, 2007, the Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following remarks.

Summary of the Office Action

In the October 11, 2007 final Office Action, Claims 4-10 and 31-33 were allowed by the Examiner. However, Claims 3 and 27-30 stand rejected. Claim 3 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,290,701 issued to Enayati (hereinafter "Enayati"). Claims 27-30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Summary of the Amendment

Upon entry of this amendment, Applicants will have amended Claims 3 and 27. Further, Claims 34-39 will have been added. By this amendment, the Applicants respond to the Examiner's comments and rejections made in the October 11, 2007 final Office Action. Applicants respectfully submit that the present application is in condition for acceptance.

Summary of Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's indication that Claims 4-10 and 31-33 are allowed. In addition, the Examiner notes that Claims 27-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph.

Traversal of Rejection under 35 U.S.C. § 112, Second Paragraph

In the October 11, 2007 final Office Action, Claim 27-30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have added new Claim 34 and amended Claim 27 in order to provide proper antecedent basis for Claims 27-30. Accordingly, Applicants respectfully request that the rejection of Claims 27-30 be withdrawn.

Traversal of Rejection under 35 U.S.C. § 102(b)

In the October 11, 2007 final Office Action, Claim 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Enayati. Applicants respectfully traverse this rejection and submit that Enayati does not disclose each and every feature recited in Claim 3. While Applicants reserve the right to prosecute Claim 3 as originally filed, Applicants have amended Claim 3 in order to expedite prosecution of this Application. Accordingly, Applicants request that this rejection be withdrawn because Enayati fails to disclose each and every feature recited in Claim 3.

Claim 3 recites a method of fixing a first piece of bone to a second piece of bone comprising the steps of, *inter alia*, “proximally retracting with the deployment tool the wire axially through the lumen such that a distal portion of the wire resists radial inward deflection of the distal anchor, thereby locking the distal anchor with respect to lateral inward movement.” As discussed below, Applicants respectfully submit that Enayati does not disclose or teach at least the above-noted features of Claim 3.

In contrast to Claim 3, Enayati discloses a “top-loading” rivet bone fastener 70 (see Enayati, Figures 8-10; see *id.* at col. 5, line 25-col. 6, line 31 and Figures 7-9) and an expansion pin 150 and a rivet bone fastener 120 (see Enayati, Figures 12-14; see *id.* at col. 6, lines 32-36, col. 5, lines 60-62; col. 6, lines 25-31; col. 7, lines 11-14).

With respect to the “top-loading” rivet bone fastener 70, shown at right in Figures 8 and 10, Enayati indicates that it “can be adapted to receive an expansion pin which is inserted through the proximal end of the axial bore.” *Id.* at col.5, lines

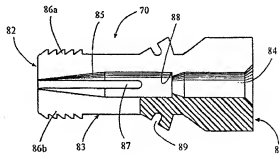


Figure 8

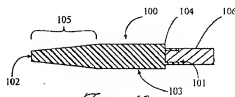


Figure 10

26-27 (emphasis added). In particular, Enayati teaches that the “distal end 102 of the expansion pin 100 is inserted into the rivet's axial bore through the proximal end thereof and urged thereinto.” *Id.* at col. 6, lines 10-12 (emphasis added). The rivet is configured to expand as the expansion pin 100 advances into the axial bore. *Id.* at col. 6, lines 12-14. The legs 86a and 86b of the rivet are fully expanded when “the circumferential shoulder 104 engages the circumferential shoulder detent 88 in the axial bore,” and “the expansion pin is locked within the axial bore by the matingly engaged shoulders 88 and 104.” *Id.* at col. 6, lines 14-19. However, Enayati fails to disclose or otherwise teach any device or method whereby the legs of the rivet can be expanded through “proximally retracting with the deployment tool the wire axially through the lumen such that a distal portion of the wire resists radial inward deflection of the distal anchor, thereby locking the distal anchor with respect to lateral inward movement,” as recited in Claim 3.

Further, the expansion pin 150 and the rivet bone fastener 120 illustrated in Figures 12-14 represent a “particularly preferred embodiment of a rivet bone fastener [in which the] expansion pin 150 (FIG. 15) housed within the axial bore . . . expands the legs of the rivet when rotated 90 degrees.” Enayati, col. 6, lines 32-36 (emphasis added). The expansion pin 150 is designed to be used with the rivet bone fastener 120 due to the elliptical shape of the distal end 151 of the pin 150. *See id.* at col. 6, line 66-col. 7, line 5. Thus, through the rotational movement of the elliptically-shaped distal end 151 of the pin 150, the legs of the rivet are able to expand. This certainly does not disclose or otherwise teach “proximally retracting with the deployment tool the wire axially through the lumen such that a distal portion of the wire resists radial inward deflection of the distal anchor, thereby locking the distal anchor with respect to lateral inward movement,” as recited in Claim 3. Accordingly, Applicants respectfully submit that this embodiment of the Enayati bone fastener also fails to disclose the above-mentioned features of Claim 3.

Therefore, Applicants respectfully request the Examiner to withdraw the rejection of Claim 3 under Section 102 and indicate that Claim 3 is allowable over the art of record.

Allowed Claims 4-10 and 31-33

Applicants gratefully acknowledge the Examiner's indication that Claims 4-10 and 31-33 are allowable.

New Claims 34-39

Applicants also hereby submit new Claims 34-39 for consideration. Claim 34 depends from independent Claims 3, and therefore, should be allowable for at least the reason that it depends from an allowable base claim. Claim 35 recites a method of fixing a first piece of bone to a second piece of bone comprising the steps of, *inter alia*, "proximally retracting the wire axially through the lumen such that a distal portion of the wire resists radial inward deflection of the distal anchor, thereby locking the distal anchor with respect to lateral inward movement." Claim 35 is believed to be allowable over the art of record. Further, Claims 36-39 should be allowable for at least the reason that these claims depend from an allowable based claim. Therefore, Applicants respectfully submit that Claims 34-39 are now in condition for allowance.

CONCLUSION

The Applicants respectfully submit that the above rejections and objections have been overcome and that the present application is now in condition for allowance. Therefore, the Applicants respectfully request that the Examiner indicate that Claims 4-10 and 27-39 are acceptable and allowed. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Applicants respectfully submit that the claims are in condition for allowance in view of the above remarks. Any remarks in support of patentability of one claim, however, should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without

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prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Applicants also have not presented arguments concerning whether the applied references can be properly combined in view of, among other things, the clearly missing elements noted above, and Applicants reserve the right to later contest whether a proper motivation and suggestion exists to combine these references.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claim and drawings in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the Applicants' attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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